

Docket No. 48811(46342)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEAPPLICANT: Hinuma, *et al.*

EXAMINER: David S. Romco

SERIAL NO.: 09/207,168

GROUP: 1647

FILED: December 7, 1998

FOR: *NOVEL PEPTIDES AND PRODUCTION AND USE THEREOF*

Mail Stop: Patent Ext.
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

**PETITION FOR REVIEW OF PATENT TERM EXTENSION UNDER
37 C.F.R. §§ 1.181, 1.701(a)(1), AND 1.701(c)(1)(ii)**

This is a Petition for Review of Patent Term Extension under 37 C.F.R. §§ 1.181, 1.701(a)(1), 1.701(c)(1)(ii), and MPEP 2720, to correct the Patent Term Extension for the above-referenced patent application. It is respectfully submitted that Patent Term Extension of three hundred thirty one (331) days accorded by the Patent Office to the above-referenced application is not correct.

Applicant requests appropriate patent term extension, pursuant to 37 C.F.R. § 1.701(c)(1)(ii), corresponding to the entire period that prosecution of the instant application was suspended due to a potential interference, the period beginning on the date of initiation of the suspension (March 5, 2003) and ending on the date of the termination of the suspension (July 7, 2005).

Attached to this Petition as **Appendix A** is a copy of the Patent Term Extension History obtained from PAIR.

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STATEMENT OF FACTS

1. The instant application was filed on December 7, 1998 as a continuation-in-part of PCT/JP97/01911, filed on June 5, 1997, which claims priority to JP 8/146052, filed on June 7, 1996.

2. On March 5, 2003, a Suspension due to Potential Interference in Another Case was initiated by the USPTO (see page 2 of Appendix A), and a Patent Office Communication reporting same was mailed to the Applicant on March 10, 2003. The Communication indicated that all claims were allowable but that due to a potential interference, *ex parte* prosecution was suspended for a period of six months from the date of the Communication. The Communication also advised Applicant to make an inquiry as to the status of the application upon expiration of the six-month period.

3. Apparently in response to a Status Inquiry filed by Applicant on October 17, 2003, a Patent Office Communication was initiated and mailed on January 29, 2004 (see page 2 of Appendix A), indicating that all claims were allowable but that due to a potential interference, *ex parte* prosecution was suspended for a period of six months from the date of the Communication. The Communication also advised Applicant to make an inquiry as to the status of the application upon expiration of the six-month period.

4. Apparently in response to a Status Inquiry filed by Applicant on July 30, 2004, a Patent Office Communication was initiated on October 18, 2004 and mailed on October 19, 2004 (see page 1 of Appendix A), indicating that all claims were allowable but that due to a potential interference, *ex parte* prosecution was suspended for a period of six months from the date of the Communication. The Communication also advised Applicant to make an inquiry as to the status

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of the application upon expiration of the six-month period.

5. On July 7, 2005, a Final Rejection was initiated and mailed on July 8, 2005 (see page 1 of Appendix A) to the Applicant, which in effect terminated suspension of prosecution of the instant application due to a potential interference, pursuant to 37 C.F.R. § 1.701(c)(1)(ii). Prior to the mailing of the Final Rejection, Applicant did not receive any indication that the suspension of the application prosecution had been terminated.

6. A Patent Term Extension of 331 days was provided for the above-referenced patent application as indicated in the Determination of Patent Term Extension under 35 U.S.C. 154 (b), mailed on November 7, 2005, which accompanied a Notice of Allowance mailed on even date.

7. Upon a review of the Patent Term Extension History obtained from PAIR (Appendix A), the calculation of 331 days for patent term extension appears to be the period beginning on March 5, 2003, the date of Suspension due to Potential Interference in Another Case and ending on January 29, 2004, with the initiating and mailing date of a Letter of Suspension. However, as set forth in paragraph 3 above, the January 29, 2004 letter was not a notification of termination of suspension but was rather a letter advising Applicant that suspension of prosecution of the instant application due to a potential interference would continue for another six months. Indeed, as set forth in paragraph 4 above and Appendix A, the Patent Office issued yet another letter, mailed October 19, 2004, advising Applicant that suspension of prosecution of the instant application due to a potential interference would continue for another six months.

8. It is clear from the foregoing that suspension of prosecution of the application was not terminated until July 7, 2005, the initiating date of the Final Rejection (see page 1 Appendix A), which effectively terminated suspension.

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9. Accordingly, Applicant submits that the patent term extension of 331 days is incorrect because appropriate Patent Term Extension should include all the time that prosecution of the instant application was suspended due to a potential interference, pursuant to 37 C.F.R. § 1.701(c)(1)(ii); *i.e.*, the correct patent term extension should be **eight hundred fifty six (856) days**, calculated from March 5, 2003, the date the suspension was initiated (see page 2 of Appendix A), to July 7, 2005, the date of the Final Rejection was initiated (see page 1 of Appendix A). (Applicant notes that 2004 was a leap year and therefore contained 29 days. This is reflected in the calculation in this paragraph and in paragraph 10 below.)

10. In the alternative, and at the least, Applicant submits that the correct patent term extension should be **seven hundred ninety six (796) days**, calculated from March 5, 2003, the date the suspension was initiated (see page 2 of Appendix A), to May 8, 2005, the date the A/R Record was closed/the status for expired suspensions reset and the application was forwarded to the Examiner (see page 1 of Appendix A).

RELIEF REQUESTED

Applicant requests the patent term extension include all days beginning on March 5, 2003 and ending on July 7, 2005. **Applicant submits the patent term extension is eight hundred fifty six (856) days.** In the alternative, Applicant requests the patent term extension include all days beginning on March 5, 2003 and ending on May 8, 2005. **Applicant submits the patent term extension is seven hundred ninety six (796) days.**

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Applicant submits that the instant Petition is being filed promptly with payment of the issue fee, on February 7, 2006. Accordingly, the instant Petition is considered timely filed.

The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter C. Lauro", is written over a horizontal line.

Date: February 7, 2006

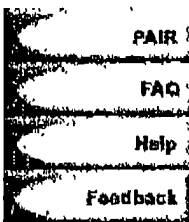
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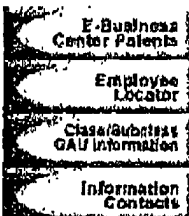


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Patent Term Extension (PTE) for application number: 09/207,168

Explanation of Calculations		Days
Filing or 371(c) Date:	12-07-1998	USPTO Delay (PTO): 331
USPTO Adjustment (days):	+0	Corrections (APPL): 0
		Total PTE: 331

Other Links



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Foreign Priority
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Publication Review

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Patent Term Extension History

Date	Contents Description	PTO (days)	APPL (days)
11-07-2005	Mail Notice of Allowance		
11-07-2005	Mail Examiner's Amendment		
11-07-2005	Notice of Allowance Data Verification Completed		
11-07-2005	Case Docketed to Examiner in GAU		
11-07-2005	Examiner's Amendment Communication		
09-12-2005	Date Forwarded to Examiner		
09-06-2005	Amendment after Final Rejection		
07-08-2005	Mail Final Rejection (PTOL - 326)		
07-07-2005	Final Rejection		
05-08-2005	Date Forwarded to Examiner		
05-08-2005	to Close the A/R Record and Reset the Status for Expired Suspensions.		
01-31-2005	IFW TSS Processing by Tech Center Complete		
05-27-2002	Request for Foreign Priority (Priority Papers May Be Included)		
05-27-2002	Request for Foreign Priority (Priority Papers May Be Included)		
10-19-2004	Mail Letter of Suspension		
10-18-2004	Letter of Suspension - Examiner Initiated		
07-30-2004	Miscellaneous Incoming Letter		
08-08-2004	Date Forwarded to Examiner		
08-08-2004	to Close the A/R Record and Reset the Status for Expired Suspensions.		
04-20-2004	Correspondence Address Change		
	Affidavit(s) (Rule 131 or 132) or Exhibit(s)		

Appendix A

05-24-2002	Received		
01-29-2004	Mail Letter of Suspension		
01-29-2004	Letter of Suspension - Examiner Initiated	331	
10-09-2003	Date Forwarded to Examiner	↑	
10-09-2003	to Close the A/R Record and Reset the Status for Expired Suspensions.	↑	
09-15-2003	Information Disclosure Statement (IDS) Filed	↑	
03-10-2003	Mail Suspension Due to Interference in Another Application	↑	
03-05-2003	Letter of Suspension - Interference in Another Case	↑	
01-17-2003	CRF Is Good Technically / Entered into Database		
01-06-2003	Date Forwarded to Examiner		
12-23-2002	Supplemental Response		
12-18-2002	Date Forwarded to Examiner		
12-02-2002	Response after Non-Final Action		
10-15-2002	Information Disclosure Statement (IDS) Filed		
08-27-2002	Mail Non-Final Rejection		
08-26-2002	Non-Final Rejection		
05-24-2002	Request for Foreign Priority (Priority Papers May Be Included)		
06-05-2002	Date Forwarded to Examiner		
05-24-2002	Response after Non-Final Action		
05-24-2002	Request for Extension of Time - Granted		
07-05-2001	Request for Foreign Priority (Priority Papers May Be Included)		
07-02-2001	Mail Non-Final Rejection		
07-02-2001	Non-Final Rejection		
04-27-2001	Date Forwarded to Examiner		
04-20-2001	Response after Non-Final Action		
04-20-2001	Request for Extension of Time - Granted		
03-27-2001	Correspondence Address Change		
10-20-2000	Mail Non-Final Rejection		
10-20-2000	Non-Final Rejection		
08-09-2000	Date Forwarded to Examiner		
07-27-2000	Response to Election / Restriction Filed		
06-24-2000	Case Docketed to Examiner in GAU		
06-20-2000	Mail Restriction Requirement		
06-19-2000	Requirement for Restriction / Election		
04-29-2000	Date Forwarded to Examiner		
02-28-2000	Response to a Letter to Comply with the Sequence Rules		
03-23-2000	CRF Is Good Technically / Entered into Database		
03-10-2000	Date Forwarded to Examiner		
12-22-1999	Mail Letter Requiring CRF (Unreadable, Non-Compliant, Not Submitted)		
12-20-1999	CRF Diskette Unreadable / Did Not Comply / Required but Not Submitted		
06-01-1999	Information Disclosure Statement (IDS) Filed		
05-05-1999	Case Docketed to Examiner in GAU		
03-23-1999	Application Dispatched from OIPE		
03-22-1999	Application Is Now Complete		
01-26-1999	Notice Mailed--Application Incomplete--Filing Date Assigned		

Appendix A

12-21-1998	IFW Scan & PACR Auto Security Review		
12-11-1998	Initial Exam Team nn		
06-12-2001	Dummy Standard Action - DO Not DELETE		

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